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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,120	10/26/2001	Majid Syed	708034-605-004	2398

7590 12/01/2009
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EXAMINER

HAMILTON, MATTHEW L

ART UNIT	PAPER NUMBER
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3688

MAIL DATE	DELIVERY MODE
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12/01/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/045,120	Applicant(s) SYED, MAJID	
	Examiner MATTHEW L. HAMILTON	Art Unit 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 and 57-96 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 and 57-96 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/10/09</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3688

Response to Amendment

1. This action is in reply to the amendment filed on 13 July 2009. Claim 96 has been added. Claim 21 has been amended. Claims 1-26 and 57-96 are currently pending and have been examined.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-26 and 57-96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee US Patent 6,374,177 B1 in view of Leeke et al. US Patent 6,587,127 B1.

Claims 1, 16, 57, 68, 76 and 87:

As per claim 1, 16, 57, 68, 76 and 87, **Lee** teaches a method, apparatus and products comprising:
communicating broadcast information to a receiver via digital radio broadcast (column 11, lines 1-15).

Lee does not teach *receiving information regarding a plurality of actions entered in a man-machine interface of said receiver and tracking said plurality of actions, said plurality of actions associated with multiple items of data content of interest.* However, **Leeke** teaches a method of operating a server interacting with users to provide personalized content to each of the users (Abstract), comprising a content player method and server with user profile in column 1, lines 10-11 and further teaches, *"Figure 24. Illustrates an example of a listening booth feature provided in the second display region 222. The listening booth feature is activated in response to receiving a user-initiated selection of the user feedback control 226. The listening booth feature can provide a venue for new music by relatively unknown talent.*

Art Unit: 3688

End users listen to the music, and provide feedback to a service via the electronic network 100." (column 22, lines 1-8) and *"The music selection is loaded into the attributes. Based on user preferences, the tracks can automatically begin playing when queued. The music selection can include samples of a few seconds from each track on an album, for example. During playback, the end user enters a rating using a control 674. The control includes 674 a marker 676 that is manipulated with respect to a numerical scale. The numerical scale 680 can run between two numerical limits, such as from 0 to 100. Upon completion of playing the samples, the user-entered rating is recorded and the music selection is counted as being rated by the end user."* (column 22, line 63 to column 23, line 7). Under *KSR v. Teleflex* (82 USPQ 2nd 1385), the combination would be obvious because prior art elements are being combined according to known methods to yield predictable results. Lee teaches a digital radio broadcast. Leeke teaches how to provide personalized content to each of the listeners of said broadcast.

In addition, **Leeke** further teaches *accumulating said information regarding said plurality of actions until a predetermined threshold associated with said plurality of actions is reached and after reaching said threshold, communicating a request for said multiple items of data content of interest* (column 23, lines 36-39).

Claims 2, 17, 58, 69, 77 and 88:

As per claims 2, 17, 58, 69, 77 and 88, **Lee** and **Leeke** teach the method, apparatus and products as in claims 1, 16, 57, 68, 76 and 87 as described above and **Lee** further teaches *further teaches wherein said actions include any of the following: storing broadcast information rendered at said receiver, clearing broadcast information rendered at said receiver, purchasing products advertised in broadcast information rendered at said receiver, purchasing said multiple items of data content of interest, or browsing other broadcast data* (column 11, lines 16-34).

Claims 3, 4, 19, 59, 60, 78 and 79:

Art Unit: 3688

As per claim 3, 4 19, 59, 60, 78 and 79, **Lee** and **Leeke** teach the method, apparatus and product of claims 1, 16, 57 and 76 as described above as described above and **Lee** further teaches *comprising receiving system information from said receiver, wherein said system information comprises time stamp information and random number information and wherein said time stamp information is a global positioning system time stamp* (column 11, lines 16-34 and lines 51-62). The Examiner notes that the claimed feature of receiving “random number information” along with the stamp information is given little, if any, patentable weight in that the claims do not include any subsequent use of the random number, thus it does not effect the invention.

Claims 5, 22, 61, 72, 80 and 91:

As per claims 5, 22, 61, 72, 80 and 91, **Lee** and **Leeke** teach the method, apparatus and product of claims 1, 16, 57, 71, 76 and 87 as described above and **Lee** further teaches *comprising authenticating said receiver* (the receiver registers and must sign in) (column 13, lines 55-67).

Claims 6:

As per claim 6, **Lee** and **Leeke** teach the method of claim 3 as described above and **Lee** further teaches *comprising communicating with an order placement service for placing an electronic order and synchronizing said order placement service for placing an electronic order and synchronizing said order placement service with a server, wherein said synchronizing is based on said time stamp information* (column 11, lines 16-34).

Claims 7, 23, 62, 71, 81 and 90:

As per claims 7, 23, 62, 71, 81 and 90, **Lee** and **Leeke** teach the method, apparatus and product of claims 1, 16, 59, 68, 78 and 87 as described above and **Leeke** teaches allowing the user to purchase an album (multiple items of data content of interest) in column 14, lines 40-42 and processing transactions by end users and clients to purchase content via a credit card in column 7, lines 32-38. An

Art Unit: 3688

album contains a variety of songs which reads on multiple items of data content of interest and processing transactions by end users and clients to purchase content reads on placing an order.

Claims 8, 20, 63 and 82:

As per claims 8, 20, 63 and 82, **Lee** and **Leeke** teach the method, apparatus and product of claims 6, 16, 62 and 81 as described above and **Lee** further teaches *of data content of interest is carried out via any of the following protocols: point-to-point protocol (PPP), transmission control protocol/Internet Protocol (TCP/IP), user datagram protocol (UDP), or wireless datagram protocol (WDP)* (column 8, lines 30-50 and column 10, lines 40-59) and also teaches allowing the user to purchase an album (multiple items of data content of interest) in column 14, lines 40-42. An album contains a variety of songs which reads on multiple items of data content of interest and processing transactions by end users and clients to purchase content reads on placing an order.

Claims 9, 64 and 83:

As per claim 9, 64 and 83 **Lee** and **Leeke** teach the method, apparatus and process of claims 1, 57 and 76 as described above and **Lee** further teaches *of data content of interest for digital radio broadcast to said receiver* (column 10, lines 60-67) and also teaches allowing the user to purchase an album (multiple items of data content of interest) in column 14, lines 40-42, which reads on *wherein said method further comprises processing said multiple items*. An album contains a variety of songs which reads on multiple items of data content.

Claim 10:

As per claim 10, **Lee** and **Leeke** teach the method of claim 1 as described above and **Lee** further teaches *on an article of manufacture* (column 11, lines 16-34) teaches allowing the user to obtain an album (multiple items of data content of interest) in column 14, lines 40-42, which reads on *wherein said method further comprises delivering said multiple items of data content of interest*. An album contains a

Art Unit: 3688

variety of songs which reads on multiple items of data content. The multiple items of interest (songs or album) are delivered once the user purchases the songs or album.

Claim 11:

As per claim 11, **Lee** and **Leeke** teach a method of claim 10 as described above and **Lee** further teaches *wherein said article of manufacture is any of the following: CD-ROM, DVD, magnetic tape, optical disc, hard drive, floppy disk, ferroelectric memory, flash memory, ferromagnetic memory, optical storage, charge coupled devices, magnetic or optical cards, smart cards, EEPROM, EPROM, RAM, ROM, DRAM, SRAM, or SDRAM* (column 11, lines 16-34). While it is not explicitly disclosed that the article of manufacturer (i.e. product) is a CD-ROM, DVD, magnetic tape, optical disc, hard driver, floppy disk, ferroelectric memory, flash memory, optical storage, charge coupled devices, magnetic or optical cards smart cards, EEPROM, EPROM, RAM, ROM, DRAM, SRAM, or SDRAM, no patentable weight is given to the type of product being purchased and delivered. Both the applicant's invention and the invention disclosed by Lee could be used to purchase any type of product from music CD-ROMs to food to insurance to cars, etc. Furthermore, Lee discusses purchasing music from a store for downloading to the receiver. Such music products are usually store on one or more of the claimed articles of manufacturer. Thus, Lee at least implies that the product could be one of the claimed types of articles of manufacture.

Claims 12, 24, 67, 73, 86 and 92:

As per claims 12, 24, 67, 73, 86 and 92, **Lee** and **Leeke** teach the method, apparatus and product of claims 1, 16, 57, 68, 76 and 87 as described above and **Lee** further teaches *wherein said digital radio broadcast is an in-band on-channel (IBOC) digital radio broadcast* (digital audio broadcast—DAB)(column 11, lines 1-15).

Claims 13, 25, 65, 74, 84 and 93:

Art Unit: 3688

As per claim 13, 25, 65, 74, 84 and 93 **Lee** and **Leeke** teach a method, apparatus and product of claims 7, 23, 62, 71, 81 and 90 as described above and **Lee** further teaches *wherein said predetermined threshold comprises any of the following:*

a threshold indicating number of actions to be recorded before placing said order (column 11, lines 16-34).

and a threshold indicating either a download time limit or content size to be reached before placing said order (column 11, lines 16-34).

Claims 14, 26, 66, 75, 85 and 94:

As per claim 14, 26, 66, 75, 85 and 94 **Lee** and **Leeke** teach the method, apparatus and product of claims 1, 16, 57, 68, 76, 87 as described above and **Lee** further teaches *wherein said threshold is modifiable over a network* (column 6, lines 21-32 and (column 11, lines 16-34). Since the threshold field is one of the parameters, it is inherent that the threshold would be modifiable by the user.

Claim 15:

As per claim 15, **Lee** and **Leeke** teach the method of claim 1 as described above and **Lee** further teaches *wherein said received broadcast information is in a format suitable for reception by an in-band on-channel digital radio receiver* (column 11, lines 1-15).

Claims 18, 70 and 89:

As per claim 18, 70 and 89, **Lee** and **Leeke** teach the method, apparatus and product of claims 16, 68 and 87 as described above and **Lee** further teaches *wherein said man-machine interface further comprises a graphical user interface (GUI)* (column 8, lines 62-67).

Claims 21 and 96:

As per claim 21, **Lee** and **Leeke** teach the method of claims 1 and 16 as described above and **Lee** further teaches *wherein said method further comprises electronically receiving* (column 11, lines 16-34).

Art Unit: 3688

Claim 95:

As per claim 95, **Lee** and **Leeke** teach the method of claim 16 as described above but do not teach *the request for said multiple items of data content of interest being communicated via a wireless uplink module at said receiver*. However, it would have been obvious to one ordinary skill in the art at the time of the invention of Lee to communicate items of interest via wireless uplink module at receiver. For example, Global Positioning System in automobiles allows user to request and receive multiple items (addresses or directions) wirelessly.

Response to Arguments

4. Applicant's arguments filed 13 July 2009 have been fully considered but they are not persuasive. Applicant's arguments on pages 16-20 of the remarks disclose, "The Office's rejection does not make out a prima case of obviousness for at least several reasons and should be withdrawn. First, one of ordinary skill in the art would not sought to modify Lee's system in view of Leeke's disclosure because doing so would have rendered Lee's vehicle based multimedia device (automotive radio) unsuitable for an intended purpose, namely safe, vehicle-based operation by a driver." Applicant has miss-represented Lee. As the first five lines of the Abstract indicate, the Lee invention is "An internet radio for portable applications". Said radio is clearly not limited to automotive applications. Even if it were limited to automotive applications, there is nothing that makes the combination unsuitable for safe, vehicle-based operation by a driver.

Applicant also argues, "Second, one of ordinary skill in the art would not have sought to modify Lee's system in view of Leeke's disclosure because doing so would have rendered Lee's vehicle-based multimedia device unsuitable for another intended purpose, namely, purchasing an individual item advertised over the broadcast airwaves "with the touch of a button". This argument is irrelevant because the instant claims are not limited to purchasing anything, much less making a purchase "with the touch of a button".

Art Unit: 3688

Applicant also argues, "Third, one of ordinary skill in the art would not have sought to modify Lee's system in view of Leeke's disclosure because there would have been no expectation of success". Applicant's subsequent discussion provides no cogent logic to support this contention. Independent claim 1 is disclosed by Leeke plus the teaching of a digital radio broadcast from Lee. What is there about the addition of a digital radio broadcast to Leeke that gives the combination "no expectation of success"? The applicant does not say. The clear answer is: nothing in the combination suggests "no expectation of success". Under *KSR v. Teleflex* (82 USPQ 2d 1385), the combination would be obvious because prior art elements are being combined according to known methods to yield predictable results. Leeke teaches every feature of the claims except digital radio broadcast. Lee teaches that missing element.

Applicant also argues, "Fourth, the reason for the Office's hypothetical modification of Lee's system is vague and unduly broad". The examiner does not agree, but, to aid applicant the arguments have been revised for clarity.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, since the references in question all pertain to receiving information regarding a plurality of actions tracked and entered by a user and accumulating information until a predetermined threshold has been reached and providing multiple items of data content, it would have been obvious to one of ordinary skill in the art at the time of the invention to collect and track information such information in order to determine if the user has met or surpassed the predetermined threshold required to receive content. Proper motivation as to why the benefits of the combination have been given in the rejections above and in the previous rejections.

Art Unit: 3688

Applicant's arguments on pages 21-22 of the remarks disclose, "There is simply no disclosure in Lee that pertains to a predetermined threshold as claimed". The Lee reference discloses "Advertising databases 196 provide information about advertisements (e.g., advertiser name, ad content, time of ad run, etc.) that are inserted into real-time radio broadcasts and into digital personalized broadcasts. In one embodiment of the system 10, when a user wishes to purchase a product or get more information about a product while in the vehicle 184, the user can press a "BUY" or "INFO" button on the multimedia device 20, which transmits to the gateway network 30 the location of his vehicle 184 (GPS derived), the date and time of the button press, and the channel selected. The advertised item is then looked up in the database 196, and the user is charged for its delivery or is sent more information about the product. In an alternative embodiment, enhanced advertising information for short periods of time may be pushed to the multimedia device 20 from the gateway 30 at set intervals. Only those ads offering immediate purchase or additional information will preferably show indicators for these actions." (column 11, lines 16-34). The Lee reference discloses that advertisement information may be pushed at set intervals (thresholds) such that ads offering additional information will show indicators for these actions such as pressing "BUY" and "INFO" button. Therefore, reading on the claimed limitation.

Applicant's arguments on page 23 of the remarks disclose, "In addition, claims 9, 21, 64, 83 recited subject matter that is further distinguishable over the Office's hypothetical modification. In particular these claims require that the requested multiple items of data content of interest are processed for digital broadcast or received via a digital radio broadcast. Neither Lee nor Leeke disclose this subject matter either singly or in combination". Applicant is not correct. As noted in the rejection, Leeke teaches the option of allowing the user to purchase a song or an album (multiple items of data content of interest) in column 14, lines 40-42, which reads on receiving multiple items of data content of interest. An album contains a variety of songs which reads on multiple items of data content...

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3688

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW L. HAMILTON whose telephone number is (571)270-1837. The examiner can normally be reached on Monday-Friday 7:30a.m-5p.m EST alt Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Weinhardt can be reached on (571) 272-6633. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MLH
Examiner, Art Unit 3688
November 2, 2009

/Donald L. Champagne/
Primary Examiner, Art Unit 3688
571-272-6717